



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/059,948	01/29/2002	David G. Hugley	5150-64300	7153
Jeffrey C. Hood Meyertons, Hood, Kivlin, Kowert & Goetzel PC P.O. Box 398 Austin, TX 78767-0398				
EXAMINER LEWIS, CHERYL RENTIA				
ART UNIT 2167				
PAPER NUMBER				
MAIL DATE 05/14/2009				
DELIVERY MODE PAPER				

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/059,948

**Applicant(s)**

HUGLEY, DAVID G.

**Examiner**

CHERYL LEWIS

**Art Unit**

2167

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-73 and 76-103 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-73 and 76-103 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This Office Action is in response to the applicant's communication received on June 22, 2007.
2. Claims 1-73 and 76-104 are presented for examination.
3. The applicant has amended claims 1, 58, and 81. The applicant has cancelled claims 74 and 75.
4. Applicants' arguments received on February 5, 2009 have been fully considered but they are not deemed to be persuasive.

### *Response to Arguments*

5a. The applicant's arguments recite the following:

#### **102 Rejection(e)**

"With regarding to claim 1, Coult fails to teach **detecting one or more resources coupled to or comprised in a computer system.**"

"With further regard to claim 1, Coult fails to teach **retrieving patent marking information corresponding to each of said one or more resources.**"

a1. The Examiner respectfully disagrees with the applicant's remarks. Coult teaches a system implementing principles of the invention (§ 0039). The system **detects** a (one) resource. The system of Coult **detects** at least one of the many resources of Coult's system as being a patent categorization engine (element 28, figure

1). The resource identified as a patent categorization engine processes patent data in a patent database (§ 0039). The patent categorization engine also produces the categorizing or mapping of patents to products (§ 0058). The patent categorization engine (resource) processes patent data in a patent database (i.e. computer). Since, the patent categorization engine is clearly identified as a resource that produces a particular functionality to process patent data, it is also clear that the patent categorization engine is ***coupled*** to a computing device identified as a patent database.

Coult teaches the patent database is a local or remote database of patents or patent data, or a plurality of databases of local or remote databases of patents or patent data. In certain applications of Coult's invention, a patent marking service may employ a patent database to map, correlate or categorize patents with products to create a "patent-product map" (§ 0056). Therefore, the patent categorization engine is ***a*** (one) ***resource coupled to*** the patent database that is ***a computer system***. Again, Coult teaches a patent database is a plurality of databases of local or remote databases of patents or patent data. The patent database employing the features of mapping, correlating or categorizing patents with products to create a "patent-product map" in Coult's patent marking service is similar to the functionality of the patent categorization engine (explained above). In that, the patent categorization engine is indeed coupled to the patent database.

Additionally, Coult's invention teaches the patent categorization engine is also coupled to a product database (element 26) as depicted in figures 1 and 1A. The product database is a database of products which a patent marking service employs to

map, correlate or categorize with patents to create a "patent-product map", "patent-product correlation", or "patent-product data" (§ 0078). The patent categorization engine is a resource coupled to the patent database and product database. The patent database and the product database are a plurality of databases which form a computer system.

The applicant's claim limitations recite "detecting one or more resources coupled to or comprised in a computer system." The limitations of this claim refer to an alternative of either one (singular) or more (plural) resources. The Examiner has at least identified one resource.

The patent marking service is **another resource that corresponds to retrieving patent marking information** (paragraph [0039], element 20). As discussed above, Coult's invention utilizes a patent marking service. The patent marking service can simply access on the Internet [www.patentmarking.com](http://www.patentmarking.com) which is (in hypothetical) the home page or other page of the web site of the patent marking service. The patent marking service has a graphical user interface which guides the user to the information desired (§ 0138). The patent marking service further utilizes a patent marking link. The link provides a URL that defines a route to a file on the World Wide Web or any other Internet facility. The URLs are embedded within the pages themselves to provide the hypertext links to other pages (§0045-0046). The domain name is [www.patentmarking.com](http://www.patentmarking.com) of the URL. Therefore, Coult's method utilizes a patent marking service employing a resource, a patent categorization engine, that is coupled to or comprised in the World Wide Web or Internet. Coult teaches the patent marking

service(s) can be accessed on a web page of the patent marking service ([www.patentmarking.com](http://www.patentmarking.com)) on the Internet. The Internet is a collection of interconnected computer networks. Since, the Internet or World Wide Web is a collection of interconnected computer networks, then Coult clearly teaches a computer system, wherein one or more resources are coupled to or comprised in a computer system.

Coult teaches several methods to retrieve patent marking information corresponding to each of one or more resources. At paragraphs 0068-0073, Coult teaches various functions for retrieving patent marking information for the patent marking service. **Coult clearly teaches patent marking information.** Coult teaches one of the chief functions of the patent marking service is building and maintaining a patent database and acquiring rights to process, copy, categorize, modify, and distribute patent numbers, copies and other patent data associated with patent data from a variety of public and private sources (§ 0068). Coult describes the patent marking service being able to *acquire* data and information from a variety of public and private sources. If the patent marking service is able to *acquire* various forms of information from various sources (public and private), then Coult clearly teaches a **means for a form of retrieval**, that is retrieving patent marking information. Coult is **retrieving** (1) rights to process, (2) copy, (3) categorize, (4) modify, and (5) distribute patent numbers, copies and other patent data associated with patent data *from a variety of public and private sources*.

Another, retrieval patent marking information technique taught by Coult includes "patent number retrieval." The patent number retrieval (element 30 of figure 1) or

"patent number retrieving" or "patent-product retrieval" refers to the querying, requesting or other "pulling" of "patent-product data," patent numbers or other such information from a patent marking service, or the "pushing" of updates of such information and other patent-product data to clients and other users (§ 0077). Coult continues by teaching several phases of execution for the "Patent Retrieval Service", element 30 of figure 1 (§ 0102). The phases of execution for the patent retrieval service consists of execution no. 1-20. For instance, in figure 1A of Coult's invention, Coult teaches patent retrieval execution, patent data, including patent numbers, are delivered, preferably by download, to client 21 (§ 0103).

The remaining claims, claims 24, 36, 58, 82, 85, 86, 89, 92, 93, 94, and 100, each comprise claim limitations corresponding substantially to the above-discussed claim limitations presented in claim 1, also, claims 24, 36, 82, 85, 86, 93, and 94, and those claims respectively dependent therefrom, each comprise limitations corresponding to the above-discussed claim limitations and are also addressed by the above remarks.

5b. The applicant's arguments recite the following:

**Section 103 Rejection**

"With regard to claim 58, Coult in view of Grainger fails to teach **receiving user input to purchase one or more software products from an e-commerce server, wherein the user input is received over a network.**"

"Grainger does not appear to relate to e-commerce at all."

b1. The Examiner respectfully disagrees with the applicant's remarks. The user of Coult's system can download electronic patent marking notices. Downloading enables the user to receive electronic patent marking notices from the network (i.e., internet). Thus, downloading electronic patent marking notices provides for an electronic exchange of products that are a previously purchased/licensed products. Therefore, the technique used by Coult's teaching to download information is an online transaction and exchange of electronic information that comprises electronic commerce. Coult teaches e-commerce.

Grainger teaches an e-commerce server (paragraph [0042]). The e-commerce server generates and sends electronic information. It also generates and sends data based on requested information and/or services, and it also can receive data and/or services.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-104 are rejected under 35 U.S.C. 102(e) as being anticipated by Coult (Publication No.: US 2002/0035571, filed September 4, 2001, priority to provisional



application no. 60/233,324 filed September 15, 2000 and priority to provisional application no. 60/289,422 filed May 8, 2001).

8. Regarding Claims 1, 24, 36, 58, 82, 85, 86, 89, 92, 93, 94, and 100, Coult teaches a digital patent marking method.

The method and associated system for a digital patent marking method as taught or suggested by Coult includes:

programmatically (§ 0063, '...primarily software...') detecting one or more resources (figure 1, element 28, patent categorization engine, § 0058, 'categorizing or mapping of patents to products') coupled to or comprised in a computer system (§ 0045-0046, 'World Wide Web or any other Internet Facility', 'The URLs are embedded within the pages themselves to provide the hypertext links to other pages.' § 0138, 'www.patentmarking.com'; § 0056, '...a patent database...'; and figure 1, § 0058 and 0130; § 0078, '...a product database...'); retrieving, a memory medium (paragraph [0035], '...a system memory'; paragraph [0127], '...a CD-ROM...') patent marking information (§ 0042-0045, figure 1, element 20, patent marking service, § 0067, 0068, '...patent marking service is building and maintaining a patent database and acquiring...', 0069-0073, 0077, '...patent number retrieval...', 0102, '...Patent Retrieval Service...', 0103, '...patent retrieval execution...', and 0130-0131) corresponding to each of one or more resources; displaying patent marking information (§ 0050, 'Bar code labels can display relevant patent data) on a display device (§ 0138, '...a graphical user interface...'); a memory (§ 0035 and 0119) operable to store program instructions (§ 0119, 'include a means for entering or programming data', § 0126, 'machine readable

code'); a processor (§ 0115, 0119, and 0161); a display (§ 0050, 0117, and 0138) coupled to the processor; downloading one or more software products (§ 0053, 'the product is downloaded software' and § 0092) to a computer system from a server over a network (§ 0046); patent marking database (§ 0039 and 0061) in response to identifying (§ 0039 and 0061).

9. Regarding Claim 2, Coult teaches one or more hardware devices (§ 0149 and 0156) coupled to the computer system.

10. Regarding Claims 3 and 59, Coult teaches the one or more resources comprise one or more software programs installed on the computer system (§ 0156).

11. Regarding Claim 4, 5, 7, 10, 11, 19, 20, 25-27, 29, 30, 34, 35, 37-40, 42, 45, 46, 53, and 54, the limitations of these claims have been noted in the rejections of independent claims 1, 24, 36, 58, 82, 85, 86, 89, 92, 93, 94, and 100 presented above. They are therefore rejected as set forth above.

12. Regarding Claims 6, 28, and 41, Coult teaches one or more resources stored identification information which identifies the respective resource (§ 0059 and 0101); detecting comprises retrieving ID information (§ 0039, 0051, 0077, 0128, and 0140); and retrieving patent marking information is performed based on ID information (§ 0039, 0051, 0077, 0128, and 0140).

13. Regarding Claims 8 and 43, Coult teaches patent marking database periodically (§ 0052, 0069, 0071, and 0073).

14. Regarding Claims 9 and 44, Coult teaches updating patent marking database when resources are detected whose patent marking information is not stored in the patent marking database (§§0052, 0069, 0071, and 0073).

15. Regarding Claims 12 and 47, Coult teaches displaying patent marking information on a computer display for a specified period of time (§§0149 and 0161).

16. Regarding Claims 13 and 48, Coult teaches displaying patent marking information on a computer display when detection occurs for the first time (§§0050, 0146, and 0149).

17. Regarding Claim 14, Coult teaches displaying patent marking information on a computer display in a periodic manner (§§0050, 0146, and 0149).

18. Regarding Claims 15, 31, and 49, Coult teaches displaying patent marking information in a Graphical User Interface (GUI) presented on a computer display (§§0050, 0146, 0149, and 0161).

19. Regarding Claims 16 and 50, Coult teaches displaying patent marking information in a pop-up dialog box (§§0042, 0096, 0149-0151), wherein pop-up dialog box is operable to close upon receiving user input (§§0042, 0096, 0149-0151).

20. Regarding Claims 17, 32, and 51, Coult teaches the means which essentially comprise the same means as GUI includes one or more icons corresponding to one or more resources (§§0042, 0096, 0149-0151) and displaying patent marking information for a first resource of one or more resources when a user moves a cursor over an icon (§§0042, 0096, 0149-0151).

21. Regarding Claims 18, 33, and 52, Coult teaches the means which essentially comprises the same means as displaying the patent marking information for each resource proximate to the respective icon of each resource (§§0042, 0096, 0149-0151).
22. Regarding Claims 19 and 56, Coult teaches a change in one or more resources coupled to or comprised in the computer system and a change of user of the computer system (§§0052, 0069, 0071, and 0073).
23. Regarding Claims 20 and 57, Coult teaches the means which essentially comprises the same means as logging onto the system and logging off the computer system (i.e. user access to World Wide Web, §§0046, 0094, 0122, and 0123).
24. Regarding Claims 23 and 55, Coult teaches executing plug and play software to detect the resource (§§0042 and 0063).
25. Regarding Claims 25, 26, 60-81, 83, 84, 87, 88, 90, 91, 95-99, 101-104, the limitations of these claims have been noted in the rejections presented above. They are therefore rejected as set forth above.

***Claim Rejections - 35 USC § 103***

26. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

27. Claims 58-73, 76-81, 89-92, and 100-104 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coult (Publication No.: 2002/0035571 A1 filed September 4, 2001) in view of Grainger (Publication No.: 2002/011824 A1 filed November 27, 2001).

28. Regarding Claims 58, 89, 92, and 100, Coult teaches receiving user input to purchase one or more software products from electronic commerce, wherein the user input is received over a network (§ 0053, '...downloading of electronic patent marking notices into or in association with previously purchased/licensed products...'; § 0054, 0169 and 0170); downloading one or more software products to a computer system ('...using downloading of electronic patent marking notices into or in association with previously purchased/licensed products, or to the purchasers/licensees where downloading into or in association with the product is not practicable. The most common application of this execution of the invention, however, is to distribute to clients, public requesters or other parties...', § 0169) over the network (§ 0033, '...network communications technology...'; § 0046, '...World Wide Web or any other Internet facility...'); retrieving patent marking information (§ 0039, 'Clients of the patent marking service 20 or other users retrieve or receive the patent-product data from the patent marking service 20 and use it in a variety of ways to patent mark products in accordance with the patent laws (denoted at 30 in FIG. 1).') corresponding to each of one or more software products based on the user input (§§ 0053-0054 and 0169-0170); and displaying patent marking information.

Coult teaches e-commerce (§ 0013). However, Coult does not expressly teach an e-commerce server.

Grainger teaches an e-commerce server (§ 0042).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the e-commerce of Coult's method with the e-commerce server of Grainger's method because Grainger's e-commerce server could enable the e-commerce method of Coult to include to generate a message that requests approval to prepare a patent application for an invention disclosure and route the message to a second client system upon receipt of a first signal indicating a request to submit the invention disclosure for approval.

29. The remaining claims are dependent claims. These claims are also rejected for being dependent on the above rejected independent claims.

### ***Conclusion***

30. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Name of Contact***

31. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Lewis whose telephone number is (571) 272-4113. The examiner can normally be reached on 6:30-3:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cottingham can be reached on (571) 272-7079. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

(571) 273-4113 (Use this FAX #, only after approval by Examiner, for "INFORMAL" or "DRAFT" communication. Examiners may request that a formal paper/amendment be faxed directly to them on occasions.).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/ Technology Center (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 10/059,948  
Art Unit: 2167

Page 15

/Cheryl Lewis/  
Primary Examiner, Art Unit 2167  
April 13, 2009